

REMARKS

Claim 10 has been amended to correct a grammatical error. Claim 16 has been amended to more actively recite the method steps. Thus, claims 9-33 are pending in the present application. Reconsideration and withdrawal of the present rejection in view of the comments presented herein are respectfully requested.

Interview Summary

Applicants' representatives would like to thank Examiners Burney and Huff for the courtesy extended to them during the telephonic interview conducted on May 11, 2010. The substance of this interview is reflected in the amendments and remarks presented herein.

Rejection under 35 U.S.C. 103(a)

The Examiner maintained the rejection Claims 9-33 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Miller et al. (US 5,427,886) in view of Hsu (US 6,051,305). The Examiner contends that it would have been obvious to use any of the known imaging compositions, including that of Miller, in the press of Hsu, and that one would have had a reasonable expectation of success in doing so.

As discussed during the telephonic interview, the presently claimed invention has two separate components in the "imaging composition," namely a toner and a reactant component, and the printable substrate contains a complementary reactant to the reactant in the imaging composition. The system thereby forms two images at the same time, one formed by the toner, and another formed by the reaction of the reactant with the complementary reactant. The second image provides evidence of tampering and that providing the complementary reactant in the substrate can further prevent fraud by revealing if non-genuine paper were used for printing.

Although Miller reference discloses a reactant and a complementary reactant, it does not disclose that the complementary reactant is present in the substrate as presently claimed. Moreover, although the core of Miller's microcapsules can be made up of a number of different materials, including a reactant or a toner, Miller nowhere teaches, or even suggests, the desirability of including both a toner and a reactant. Thus, nothing in Miller suggests either that two different types of images can be formed, or that a complementary reactant should be included in the substrate. In fact, Miller provides no motivation to include the complementary reactant in

the substrate since the method disclosed in this reference does not relate to the production of two separate images.

Although the first paragraph of the detailed description of Miller appears to disclose a three component system, the three components are two different reactants and a developer. During the interview, the Examiners agreed that nothing in that paragraph suggested the production of two different images as recited in the present claims. Although the description in Column 6, lines 23-25 of Miller, in which the capsule core material is described as including ingredients that could be reactants, as well as toner, there is no suggestion to include both ingredients in the same formulation so as to produce two separate images as presently claimed.

Hsu does not remedy either of the foregoing deficiencies of the Miller reference. Hsu clearly does not teach anything about producing two different types of images (both a toner image and a security feature) on a substrate. Moreover, Hsu actually teaches away from including a complementary reactant in the substrate because the main point of Hsu appears to be that no special priming of the substrate is necessary (see abstract and col. 2, lines 19-20). Therefore, the combination of Miller with Hsu would not lead one having ordinary skill in the art to the liquid toner digital press imaging system or anticounterfeiting method recited in claims 9/10 and 16, respectively.

As noted in MPEP § 2143, “The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.” *KSR v. Teleflex*, 550 U.S. at 398, 82 USPQ2d at 1395. As discussed above, neither Miller nor Hsu disclose or suggest a system for producing both a toner image and a security feature on a substrate, in which the security feature is detectably retained on the substrate even if the toner image is removed. Thus, even when combined, these references would not produce the present invention. Accordingly, the combination of Miller and Hsu does not support a *prima facie* showing of obviousness with respect to the presently pending claims.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

CONCLUSION

Applicants submit that all claims are in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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